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08/241,170 APPLICATION NO.	05/20/97 FILING DATE	HM42/0728 MCFAREIRST NAMED INVENTOR	E ATTORNEY DOCKET NO. 65304-020
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ERIC M. DOBRUSIN, ESQ.
RADER, FISHMAN & GRAUER, PLLC
1533 N. WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS MI 48304

EXAMINER RIGIOLIANO, J

ART UNIT 1527	PAPER NUMBER 21
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DATE MAILED: 07/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/941,170

Applicant(s)
MacFarlan et al

Examiner
Joseph W. Ricigliano Ph. D.

Group Art Unit
1627



☒ Responsive to communication(s) filed on Dec 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 5-15, 39-57, and 62-69 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1, 5-15, 39-57, and 62-69 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/941,170 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restriction

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

- I. Claims 1, 5-15 and 41-57, drawn to an apparatus, classified in class 435, subclass 287.1.

- V Claims 39, 40 and 62-69 drawn to a testing apparatus classified in numerous subclasses of class 324.

Applicants have canceled the claims to the non-elected inventions (groups II and IV) and have introduces several new species claims. In view of the forgoing the following further election of species is set forth.

2. The inventions of group I and V are related as distinct apparatus. The apparatus are distinct as they have different components. The apparatus of group I provide components for the preparation of arrays whereas the apparatus of group V only provides components for the testing

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of arrays. For example the apparatus of group has source materials (e.g., ions that can be deposited etc) whereas the apparatus of group V does not.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group V, restriction for examination purposes as indicated is proper.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

If applicant elects the invention of group II applicants is required to elect from the following patentably distinct species of invention

A) Species of detector and electrical property to be detected

- i) claim 40, AC impedance
- ii) claim 65, superconductivity
- iii) claim 66, critical current.
- iv) claim 67, conductivity
- v) claim 68, dielectric constant
- vi) claim 69, dielectric strength

Currently, claims 39 is generic to the invention of group V

4. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Ricigliano Ph. D. whose telephone number is (703) 308-9346.

The examiner can be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams Ph. D., can be reached at (703) 308-0570.

BENNETT CELSA
PRIMARY EXAMINER


3/6/00

Joseph W. Ricigliano Ph. D.